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In re Application of  
IMOTO, et al.  
U.S. Application No.: 09/355,117  
PCT No.: PCT/JP00/01190  
Int. Filing Date: 01 March 2000  
Priority Date: 05 March 1999  
Attorney Docket No.: 1830/50325  
For: HETEROCYCLIC COMPOUNDS  
HAVING EFFECT OF ACTIVATING  
NICOTINIC ACETYLCHOLINE ALFA4  
BETA2 RECEPTOR

DECISION ON PETITION

UNDER 37 CFR 1.181

This decision is in response to applicant's "Petition Under 37 C.F.R. § 1.182" filed 25 April 2003 in the United States Patent and Trademark Office (USPTO). The petition is being treated as a petition under 37 CFR 1.181. No petition fee is due. The initial papers filed 22 August 2001 were processed as a filing under 35 U.S.C. 111(a). For the reasons discussed below, the application will be converted to a national stage filing of PCT/JP00/01190.

**BACKGROUND**

On 01 March 2000, applicant filed international application PCT/JP00/01190 which claimed a priority date of 05 March 1999. A Demand was filed with the International Preliminary Examining Authority prior to the expiration of 19 months from the priority date, and as a result the deadline for payment of the basic national fee was extended to expire 30 months from the priority date, i.e. 05 September 2001.

On 22 August 2001, applicant filed the present application. The application papers filed therewith included a transmittal letter; a specification containing 27 claims, a signed combined declaration and power of attorney; a preliminary amendment; an Information Disclosure Statement and a check in the amount of \$1,106.00 as payment of the U.S. Basic National Fee and a check in the amount of \$40.00 for the recording of an assignment. In addition, applicant authorized the charging of any additional fees to Deposit Account No.: 05-1323. None of the papers referred to 35 U.S.C. 371 or "national stage." The application was processed as a filing under 35 U.S.C. 111(a).

On 25 April 2003, applicant filed the present petition under 37 CFR 1.182 to have the application converted to a PCT National phase application under 35 U.S.C. 371. Applicant

included payment of the \$130.00 petition fee.

### DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official USPTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or

2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application.

An examination of the application file finds that in the declaration filed 22 August 2001, the applicant clearly identifies the specification to which it is directed by referring to international application PCT/JP00/01190. This is a clear indication that the papers were filed under 35 U.S.C. 371. The transmittal letter did not contain any instructions in conflict therewith. As such it is proper to grant applicant's petition at this time and process the application under 35 U.S.C. 371 instead of 35 U.S.C. 111.

### CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.181 is GRANTED. The application will be converted from a 35 U.S.C. 111 filing to a national stage application under 35 U.S.C. 371.

As discussed above, no petition fee is required. As such, \$130.00 will be credited to Deposit Account No.: 05-1323.

This application has an international filing date of 01 March 2000 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of 22 August 2001.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision, that is, for mailing of a Notification of Acceptance of Application (Form PCT/DO/EO/903) and Official Filing Receipt which identifies this application as a national stage application of PCT/JP00/01190.

Thereafter, the application will be forwarded to Art Unit 1624.



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